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**REMARKS**

By this Amendment, Applicants amend claim 30. Claims 1-17 and 30-46 remain pending in this application. In the Office Action of June 2, 2005,<sup>1</sup> claims 1, 2, 5, 7-10, 12, 13, 15, 16, 30, 31, 34, 36-39, 41, 42, 44, and 45 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,363,434 to *Eytchison*; claims 6, 11, 14, 17, 35, 40, 43 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Eytchison* in view of Official Notice; and claims 3, 4, 32, and 33 were objected to as being dependent upon a rejected base claim. Applicants appreciate the Examiner's indication of allowable subject matter and address the objection and rejections below.

**Objection to claims 3, 4, 32, and 33**

The Examiner objected to claims 3, 4, 32, and 33 as being dependent upon a rejected base claim, indicating these claims would be allowable if rewritten in independent form with all base and intervening claim recitations. Because claims 3, 4, 32, and 33 depend, directly or indirectly, upon claims 1 and 30 (which should be allowed over the cited art for at least the reasons presented below), Applicants request withdrawal of the objection and the timely allowance of these pending claims.

**Rejection under 35 U.S.C. § 102(e)**

Applicants traverse the rejection of claims 1, 2, 5, 7-10, 12, 13, 15, 16, 30, 31, 34, 36-39, 41, 42, 44, and 45 under § 102(e) because *Eytchison* fails to anticipate the claims. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly described or under principles of

<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

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inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

Independent claim 1 recites a combination including “attempting, by a portable access device, to establish a communication link between the portable access device and said first network server using one of a plurality of communication media, in accordance with said communication protocol.” Contrary to the Examiner’s position, *Eytchison* does not teach at least this feature.

The Examiner alleged that *Eytchison*’s media devices 210, 211, 212, and 222a “read as portable access devices” and “are in communication with a server (214).” Office Action (“OA”) page 2. The Examiner further alleged that “[*Eytchison*’s] resource manager identifies communications protocols . . . and establishes the communication connection.” *Id.*

In *Eytchison*’s system, a user application (310) in a home server (214) sends a request to a resource manager (320), also in the home server. When the resource manager grants the request, the resource manager transmits control commands to software device proxies (370a-370i) in the home server, which in turn control the source and destination media devices (210, 211, 212, 222a). See col. 6, line 64 – col. 7, line 9. Even if, as the Examiner contends, *Eytchison*’s media devices 210, 211, 212, and 222a “read as portable access devices,” *Eytchison* does not teach the “attempting” recited in claim 1. In *Eytchison*’s system, the media devices 210, 211, 212, and 222a do not attempt to establish a communication link between themselves and a first network server . . .” Instead, as explained above and by the Examiner’s own admission, the resource manager 320 in the home server 214, not the media devices, establishes communications between devices. *Eytchison* thus does not teach “attempting, by a portable

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access device, to establish a communication link between the portable access device and said first network server using one of a plurality of communication media, in accordance with said communication protocol,” as recited in claim 1 (emphasis added). To the extent *Eytchison* could be construed as teaching “attempting” to establish a communication link between a portable access device and a network server, such attempting would be performed by the resource manager 320 in the home server 214, not “by a portable access device,” as recited in claim 1.

Because *Eytchison* does not teach each and every element of claim 1, as a matter of law, it cannot anticipate this claim. As such, the rejection of claim 1 under 35 U.S.C. §102(e) based on *Eytchison* should be withdrawn. Claims 2 and 5 depend upon claim 1 and are distinguishable from *Eytchison* for at least reasons similar to those presented above in connection with claim 1. Accordingly, Applicants request withdrawal of the § 102(e) rejection and the timely allowance of claims 1, 2, and 5.

Independent claim 7 recites a combination including:

receiving a request from a portable access device to access a network server;

identifying a communication protocol associated with said network server; [and]

transmitting said communication protocol to said portable access device.

*Eytchison* fails to teach or suggest at least the above-noted features.

First, *Eytchison* does not teach “receiving a request from a portable access device to access a network server,” as claimed. Instead, *Eytchison* discloses that a resource manager (320) located in a home server (214) receives a request from a user application (310), which is also located in the home server. See col. 6, lines 64-67. Receiving a request from a user application, as mentioned by *Eytchison*, does not constitute receiving a request from a portable access device,

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as claimed. Thus, *Eytchison* fails to teach at least “receiving a request from a portable access device to access a network server,” as claimed.

Further, *Eytchison* fails to teach at least “identifying a communication protocol associated with said network server . . . [and] transmitting said communication protocol to said portable access device,” as recited in claim 7. In *Eytchison*’s system, the resource manager checks whether sufficient bandwidth is available and, if the bandwidth is available, transmits control commands to software device proxies in the home server, which in turn control the source and destination media devices. Checking for bandwidth and transmitting control commands from a home server to software proxies located in the home server, as described by *Eytchison*, does not constitute “identifying a communication protocol associated with the network server and transmitting said communication protocol to the portable access device,” as claimed. Although *Eytchison*’s software proxies control the media devices, *Eytchison* does not disclose transmitting an identified communication protocol associated with the server to the media devices.

Because *Eytchison* does not teach each and every element of claim 7, as a matter of law, it cannot anticipate this claim. As such, the rejection of claim 7 under 35 U.S.C. §102(e) based on *Eytchison* should be withdrawn. Claims 8-10 depend upon claim 7 and are distinguishable from *Eytchison* for at least reasons similar to those presented above in connection with claim 7. Accordingly, Applicants request withdrawal of the § 102(e) rejection and the timely allowance of claims 7-10.

Independent claim 30 recites, *inter alia*:

attempting, by a portable access device, to establish a communication link between the portable access device and said first network server using one of a plurality of communication media, in accordance with said communication protocol.

And independent claim 36 recites, *inter alia*:

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receiving a request from a portable access device to access a network server;

identifying a communication protocol associated with said network server; [and]

transmitting said communication protocol to said portable access device.

The §102(e) rejection of claims 30 and 36 based on *Eytchison* should be withdrawn for at least reasons similar to those presented above in connection with claims 1 and 7, respectively. The rejection of claims 31, 34, and 37-39 should be withdrawn as well, at least because of the respective dependence of those claims upon claims 30 and 36. Accordingly, Applicants request withdrawal of the § 102(e) rejection and the timely allowance of claims 30, 31, 34, and 36-39.

Each of independent claims 12 and 41 recites a combination including:

transmitting from a portable access device to a first network server a request to access a second network server;

receiving said request at said first network server;

identifying a communication protocol associated with said second network server;

transmitting said communication protocol from said first network server to said portable access device; and

establishing a communication link between said portable access device and said second network server.

Initially, Applicants point out that the Examiner has not substantively addressed the above features of claims 12 and 41 in the Office Action. In particular, the Examiner did not address the elements recited in claims 12 and 41 of a first and second server. Instead, the Examiner merely reproduces, verbatim, the same arguments presented for rejecting claim 7, which appear identical to the arguments presented in the last Office Action.

Applicants remind the Examiner that:

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[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. M.P.E.P. § 706 (8th ed. 2001).

Applicants also remind the Examiner of the provisions of M.P.E.P. § 706.02(j), which include:

[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply...[and]

the examiner should set forth in the Office action...the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate.

The rejection of claims 12 and 41 as set forth in the Office Action is ambiguous and does not provide Applicants a fair opportunity to reply. For example, the rejection does not articulate which features the Examiner believes the reference teaches. Should the Examiner continue to dispute the patentability of Applicants' claims, Applicants request a new non-final Office Action setting forth the relevant teachings of the prior art relied upon in the rejection of claims 12 and 41.

The Office Action's failure to address claims 12 and 41 notwithstanding, Applicants submit the following remarks in response to the Office Action. As explained above, the Examiner rejected claims 12 and 41 for the same reasons as presented for rejecting claim 7. Applicants disagree with the Examiner's interpretation of *Eytchison*. For example, receiving by a resource manager in a server a request from a user application in that same server is not consistent with receiving at a first network server a request from a portable access device to access a second network server, as claimed. Moreover, neither "controlling communications lines and bandwidth allocations" nor "allocating lines and bandwidth" (OA, page 4) is consistent with transmitting a communication protocol associated with a second network server to a

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portable access device from a first network server, as claimed. For at least these reasons, the rejection of independent claims 12 and 41 under 35 U.S.C. §102(e) should be withdrawn. The § 102(e) rejection of dependent claims 13, 15, 16, 42, 44, and 45 should be likewise withdrawn, for at least reasons similar to those presented above in connection with claims 12 and 41. Applicants thus request withdrawal of the § 102(e) rejection of claims 12, 13, 15, 16, 41, 42, 44, and 45 and the timely allowance of these pending claims.

**Rejection under 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claims 6, 11, 14, 17, 35, 40, 43 and 46 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Eytchison* "in view of Official Notice" (OA at 5). As M.P.E.P. § 2142 states, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

In rejecting claims 6, 11, 14, 17, 35, 40, 43 and 46, the Examiner alleged (OA, page 6):

*Eytchison* only differs from the claims in that the portable devices are hardwired to the server as opposed to being connected in a wireless manner. However, examiner takes Official Notice that it is well-known in the art to establish data communication links using wireless connections. It would have been obvious to one of ordinary skill in the art to modify *Eytchison* to utilize wireless connections on the LAN illustrated in FIG. 2 so as to enhance the

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convenience of the user by eliminating the need to plug wires into the portable devices.

Claims 6, 11, 14, 17, 35, 40, 43 and 46 depend upon claims 1, 7, 12, 30, 36, and 41. For at least the reasons presented above, *Eytchison* does not teach or suggest each and every element recited in claims 1, 7, 12, 30, 36, and 41. *Eytchison* thus does not teach or suggest each and every element recited in dependent claims 6, 11, 14, 17, 35, 40, 43 and 46.

Moreover, the Examiner has not taken Official Notice that *Eytchison*'s deficiencies with respect to claims 1, 7, 12, 30, 36, and 41 were well known or established that it would have been obvious to modify *Eytchison* to include the missing features. Because the applied art does not teach or suggest each and every element recited in claims 1, 7, 12, 30, 36, and 41 and required by dependent claims 6, 11, 14, 17, 35, 40, 43 and 46, *prima facie* obviousness has not been established.

Additionally, Applicants traverse the Examiner's taking of Official Notice regarding "using wireless connections" (OA at 6). Applicants call the Examiner's attention to the provisions of M.P.E.P. § 2144.03, regarding the "Procedure for Relying on Common Knowledge or Taking Official Notice" and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. M.P.E.P. § 2144.03 sets forth that "the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'" Further, any facts asserted as well-known should serve only to "fill in the gaps" in an insubstantial manner. It is never appropriate to rely solely on "common



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knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based.

Applicants submit that the elements recited in claims 6, 11, 14, 17, 35, 40, 43 and 46 regarding wireless transmission were not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Applicants point out that “[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is “basic knowledge” or “common sense.”” *In re Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 258 F.3d at 1385, 59 U.S.P.Q.2d at 1697 (Fed. Cir. 2001).

As M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted). The Office Action does not provide substantial evidence on the record to show that Applicants’ claimed features were unquestionably well-known.

Applicants expressly traverse the Examiner’s taking of Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of the conclusions in the Office Action, or else withdraw the rejection. To the extent the Examiner is relying on personal knowledge in alleging that certain subject matter was well known, Applicants request that the Examiner provide “an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” See M.P.E.P. § 2144.03.

Moreover, regardless of whether “using wireless connections” was well known, as alleged by the Examiner, *prima facie* obviousness has not been established for at least the

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following reasons. Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Moreover, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show, by “clear and particular” evidence, that a skilled artisan considering *Eytchison*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify the reference in a manner resulting in Applicants’ claimed combination. The Examiner alleged that a skilled artisan would have modified the reference “so as to enhance the convenience of the user by eliminating the need to plug wires into the portable devices” (OA at 6). This conclusory allegation in the Office Action is not properly supported and does not establish a motivation or suggestion for modifying *Eytchison*. For example, the Examiner points to evidence in *Eytchison* mentioning such an “enhanced convenience.” Applicants call attention to M.P.E.P. § 2143.01, which makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted).

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

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would have been obvious (internal citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.* In this case, the Examiner merely alleged that *Eytchison* discloses certain elements and that certain elements were well known, without showing reasons that a skilled artisan would select or modify those elements in the manner claimed and without showing that the claimed invention as a whole would have been obvious. Even if the use of wireless connections were well known, the conjectural conclusions set forth in the Office Action do not suffice to establish a *prima facie* conclusion of obviousness. Furthermore, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

In addition, as noted above, *prima facie* obviousness requires a reasonable expectation of success in modifying the reference at the time the invention was made. *See* M.P.E.P. § 2143.02. In this case, there is no evidence on the record to support the notion that a reasonable expectation of success would have existed at the time of the invention arising from the modification of *Eytchison* “to utilize wireless connections.” *Eytchison* explains that the electronic media devices (e.g., VCR, TV, CD player, DVD player) are connected to the home server via an IEEE 1394-1995 bus, which is used to provide multiple channels for isochronous data transfers (col. 5., line 30 – col. 6, line 5). The Examiner fails to show that there would have been a reasonable

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expectation of success arising from providing multiple channels for isochronous data transfers wirelessly at the time of the invention. That is to say, there is no evidence on the record to support the notion that, at the time the invention was made, there would have been a reasonable expectation of success from providing wireless transmission of the IEEE 1394 protocol. Indeed, Applicants submit that there would not have been a reasonable expectation of success from providing wireless multiple-channel isochronous data transfer for electronic media devices (e.g., VCR, TV, CD player, DVD player).

For at least the foregoing reasons, a *prima facie* case of obviousness has not been established with respect to claims 6, 11, 14, 17, 35, 40, 43 and 46. Applicants therefore request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

#### Conclusion


The claimed invention is neither anticipated nor rendered obvious in view of the art cited against this application. Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2347.

Respectfully submitted,

Dated: August 31, 2005

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